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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,782	07/13/2001	Suresh K. Tikoo	293102002900	1838
25226 7590 12/28/2006 MORRISON & FOERSTER LLP 755 PAGE MILL RD PALO ALTO, CA 94304-1018			EXAMINER HILL, MYRON G	
			ART UNIT 1648	PAPER NUMBER
			MAIL DATE 12/28/2006	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/904,782	Applicant(s) TIKOO, SURESH K.	
	Examiner Myron G. Hill	Art Unit 1648	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 September 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 29 September 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1, 5-8, 11, 14, 15, 18-21, 29, 30 and 39-44.
Claim(s) withdrawn from consideration: 9, 12, 13, 22-28 and 31-40.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant argues that the cited art does not contain figures, that the rejection provides no motivation to combine and no expectation of success and also does not teach or suggest all the limitations. Also, that parallel is art known.

Applicant's arguments have been fully considered and found persuasive in part.

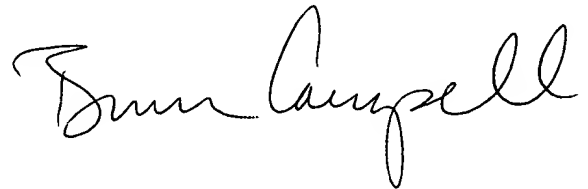
The 112 second rejection for parallel is withdrawn after consideration of the supplied art Yaresh et al.

The 103 rejection is maintained. The Examiner has looked and the inclusion of figures in reference to Lusky is in error. The limitations are present in the disclosure of Lusky. Lusky teach in Examples 1-3 that BAV3/Ads5 chimera is replication competent in bovine cells and that BAV3 encapsidation signals used in the virus or vector do not encapsidate in human 293 cells. Claims 1, 5, and 6 point out a BAV3 vector as used in the examples. The instant claims do not require that the vector be full length BAV3 but merely a vector. The vector of Lusky acts as a BAV3 vector because it is replication competent in bovine cells. Applicant argues that the reference teaches replication defective Ad vectors which are deleted in E1 region. As pointed out above, adenovirus can be replication competent depending on the cell line used. The instant claims are not limited to particular cell or a method using a particular cell. Applicant also argues about E1 deletions and that they are not replication competent. There is no limitation in the claims requiring the vectors contain or omit E1 deletions as part of the replication competent phenotype.

The level of skill in the art is high and the use of adenovirus as expression vectors is well known. One of ordinary skill in the art would be able to make a range of adenovirus constructs for expression of heterologous genes. Matthews et al. teaches that introns increase the level of gene expression using an intron is recognized by Matthews (page 351, column 2, middle) and that it is a hybrid intron (page 346, column 1, last full paragraph). Heterologous promoters are used both in Kaufman and Matthews. Kaufman et al. disclose the other features of the intron (Figure 8, splice donor acceptor sites and that the splicing is correct, page 1316, column 1, start of last part paragraph). While the word "strong" is not used, the splicing appears fully functional. Where, as here, the Patent Office lacks the facilities to perform comparisons between the claimed material and prior art materials that reasonably appear to meet the claim limitations, the burden is properly shifted to applicant to distinguish the claimed product from the prior art product. See *In re Best, Bolton, and Shaw*, 195 USPQ 430 (CCPA 1977); *Ex Parte Gray*, 10 USPQ2d 1922 (BPAI 1989).

Thus the rejection is maintained.

WJ
12/2/06



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